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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

RECOGNICORP, LLC,

Plaintiff,

v.

NINTENDO CO. LTD.,

Defendant.

Case No. CV 12-1873-RAJ

NINTENDO'S MOTION TO STRIKE
INFRINGEMENT CONTENTIONS AND
TO RELIEVE NINTENDO OF
DISCOVERY OBLIGATIONS;
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT THEREOF

**NOTE ON MOTION CALENDAR:
April 5, 2013**

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Nintendo moves this Court to strike RecogniCorp, LLC's Infringement Contentions (ICs) for failure to comply with L.P.R. 120. All of RecogniCorp, LLC's ICs fail to identify "specifically where each limitation of each asserted claim is found within each Accused Instrumentality" as required by the Rules. L.P.R. 120(c).

II. FACTS AND BACKGROUND

A. The Parties

Plaintiff RecogniCorp, LLC ("RecogniCorp") is headquartered in Round Rock, Texas. It was formed on November 14, 2011, approximately one month before this case was filed. On information and belief, RecogniCorp neither makes nor sells any products. On information and belief, RecogniCorp was formed solely for the purpose of filing suits for patent infringement.

Defendant Nintendo Co., Ltd. ("NCL" OR "Nintendo") is a Japanese company which makes and sells home and personal entertainment products including video and electronic games and related devices. Nintendo of America Inc. ("NOA") is a Washington corporation, headquartered in Redmond, Washington. NOA is a wholly owned subsidiary of NCL. NOA is the exclusive North American distributor of products made by NCL.

B. The Accused Products

This is a case for alleged patent infringement. The products accused of infringement are described in the Complaint as: "Nintendo composite image customization products that infringe the '303 Patent include, but are not limited to, software included on the Nintendo Wii to create and customize a facial (or other) feature of a Mii". Complaint, ¶ 15.

C. The Patents-In-Suit -- The Significance of "Coding" and "Codes" in Creating Composite Images

The patent-in-suit is U.S. Pat. No. 8,005,303 ("the '303 patent"), entitled "Method/Apparatus for Encoding/Decoding Image Data". The Abstract summarizes the subject matter of the '303

1 patent as follows: "The invention relates to a method and an apparatus for encoding images,
 2 more particularly to an encoding unit in conjunction with a library of pictorial entities and image
 3 qualifiers. The method and apparatus provide for encoding an image by using a code factor table
 4 in conjunction with a set of element codes. The resulting image code allows the set pictorial
 5 elements of an image and their associated image qualifiers to be represented by a compact code
 6 uniquely representing a given configuration of pictorial elements. The use of the resulting image
 7 code facilitates the transmission and storage of images requiring only the code to be sent or
 8 stored. The invention further provides a computer readable medium comprising a program that
 9 direct a computer to implement the encoding process."

10 As can be seen from the Abstract, and from the title of the patent, "codes", and related
 11 concepts such as "code factors," are central to the '303 patent. Indeed, each claim of the '303
 12 patent includes multiple limitations calling for "codes" or "code factors" of some sort.
 13 Independent claim 1 requires: "facial feature element codes"; a "composite facial image code;
 14 and a "facial feature element code". Independent claim 16 requires: "facial feature element
 15 codes", a "composite image code", a "facial feature element code", and a "composite image
 16 code." Independent claim 23 requires "facial feature element codes", a "composite image code",
 17 and a "facial feature element code". Independent claim 23 requires "facial feature element
 18 codes", and a "composite image code". Independent claim 29 requires "facial feature element
 19 codes", a "composite facial image code", and a "facial feature element code". Independent claim
 20 36 requires "facial feature element codes", and a "composite image code".

21 The specification of the '303 patent states, in the "Field of the Invention": "This
 22 invention relates to a method and apparatus for encoding/decoding image data..." The prior art
 23 discussed in the specification pertains to creating composite images of faces, using such features
 24 as hair, eyes, nose, mouth, and chin. Exh. 1, Col. 1, ll. 36-41. The specification states that, in
 25 the prior art, composite facial images were made using paper strips containing exemplary
 26 features that are arranged to form a composite drawing of a face. Exh. 1, Col. 1, ll. 41-43. A use

1 cited is for law enforcement. Exh. 1, Col. 1, ll. 34. In the prior art as discussed in the patent,
 2 creating a composite facial image was also done by use of a computer that allowed a user to
 3 select individual components, such as eyes or noses, and combining them on a pre-selected face.
 4 Exh. 1, Col. 1, ll. 43-46.

5 According to the specification, the patent is about reducing memory and bandwidth
 6 requirements for the storage and transmission of composite (facial) images by using a "new"
 7 encoding system. The patent states that a drawback of the prior art systems is that storage of the
 8 images required "significant amounts of memory." Exh. 1, Col. 1, ll. 60-61. If the images are
 9 compressed so as to require less memory, their quality is degraded. Exh. 1, Col. 2, ll. 1-4. The
 10 size and quality of the images is important particularly when they are transmitted from one site to
 11 another, for example from one police station to another to share information about a given
 12 suspect. Exh. 1, Col. 2, ll. 4-9. The need that is identified in the prior art, that is allegedly met
 13 by the '303 patent, is "to refine the process of encoding images" so as to reduce the memory
 14 requirements and the bandwidth required for the transmission of the images. Exh. 1, Col. 2,
 15 ll. 9-13.

16 **D. RecogniCorp's ICs Do Not Identify Where Each Limitation Is**
 17 **Allegedly Found In Each Accused Product.**

18 **1. RecogniCorp's Claim Charts For The '303 Patent Do**
 19 **Not Show Where Any "Codes" or "Code Factors" Of**
Each Accused Instrumentality Are Allegedly Found.

20 As discussed above, "codes" and "code factors" are central to the '303 patent and are
 21 found throughout the claims. RecogniCorp's ICs fail to comply with L.P.R. 120 with respect to
 22 any of the numerous "code" limitations in the asserted claims. In each instance, RecogniCorp
 23 says discovery is required before compliant ICs can be provided. The alleged need for
 24 "discovery" is not a proper basis for failing to comply with the requirements of L.P.R. 120.
 25 Moreover, the excuse that "discovery is needed" is particularly inappropriate in this case,
 26 because the plaintiff has not even served any discovery requests.

1 RecogniCorp has asserted all claims (claims 1-42) of the '303 patent against all of the
 2 accused Nintendo products. Exh. 2, p. 2. Claim 1 reads as follows, with the elements that are
 3 not mapped to the accused instrumentalities emphasized:

4 **Claim 1.** A method for creating a composite image, comprising:

5 displaying facial feature images on a first area of a first display via a
 6 first device associated with the first display, wherein the facial feature
 images are associated with facial feature element codes;

7 selecting a facial feature image from the first area of the first display
 8 via a user interface associated with the first device, wherein the first
 9 device incorporates the selected facial feature image into a composite
 image on a second area of the first display, wherein the composite
 image is associated with a composite facial image code having at least
 10 a facial feature element code; and

11 reproducing the composite image on a second display

12 based on the composite facial image code.

13 Exh. 1, Col. 12. All the independent claims, 1, 16, 23, 29, and 36, include both of these
 14 limitations of "facial feature element codes" and a "composite facial image code having at least a
 15 facial feature element code." Since every independent claim includes these limitations, they are
 16 also effectively present in all the dependent claims. Therefore, RecogniCorp's inadequate
 17 infringement contentions affect all the claims in this case.

18 Further, in RecogniCorp's Contentions regarding Nintendo's 3DS and 3DS XL
 19 (collectively, "3DS"), all the independent claims of the '303 patent require a first and second area
 20 of a "first display" or "first screen," but RecogniCorp alleges that the *two separate screens* of the
 21 3DS meet this requirement based on nothing but "information and belief." Exh. 5, p. 2. The
 22 "first screen" limitation in claim 1 (emphasized above - "first area of the first display" and
 23 "second area of the first display) is illustrative.

24 In addition, for every independent claim, there is a dependent claim (specifically, claims
 25 10, 19, 24, 32, and 38) that requires a "code factor." RecogniCorp has also failed to indicate
 26

specifically where the "code factor" is allegedly found in any accused device or method. Claim 10 of the patent, which is representative, is reproduced below:

Claim 10. The method of claim 1, wherein the composite image code includes or is based on one or more code factors.

Exh. 1, Col. 13.

The "facial feature element codes" limitation.

RecogniCorp's claim charts (hereinafter referred to as "claim charts") give no support to this limitation. They instead parrot the claim language ("In the Accused Instrumentalities, the facial feature images are associated with facial feature element codes") and add this statement: "On information and belief, a review of Defendant's information provided in discovery, including but not limited to technical specifications and/or source code, will confirm that the facial feature images are associated with facial feature element codes." Exh. 3, p. 2 *et seq.* This statement does not provide any information besides the claim language itself. It is inappropriate to "simply mimic[] the language of the claim," providing "no further information to defendants than the claim language itself."). *Network Caching Technology, LLC v. Novell, Inc.*, 2002 U.S. Dist. LEXIS 26098, *18, (N.D. Cal. Aug. 13, 2002) ("*Network Caching I*")¹.

Since RecogniCorp is apparently in possession of a Wii console, a Wii U, and a Nintendo 3DS and 3DS XL,² it should be able to reverse engineer them and state specifically where and what the "codes" and "code factors" discussed herein are. *Network Caching I*, 2002 U.S. Dist. LEXIS 26098, at *5 (Reverse engineering or its equivalent is required for Infringement Contentions).

¹ Due to the amount of precedent available to interpret and apply the Local Patent Rules, this Court has stated that cases interpreting the local patent rules for the Northern District of California are "useful" because of the similarity between the language of the local patent rules for in both Districts. *Allvoice Developments US, LLC v. Microsoft Corp.*, No. 10-02102, p.2, FN. 2 (W.D. Wash., December 27, 2012).

² As evidenced by the "screenshots" in RecogniCorp's Infringement Contentions.

1 ***The “composite facial image code” limitation.***

2 As with the facial feature element codes limitation, RecogniCorp's claim charts also fail
 3 to support this limitation, but again simply parrot the claim language and state that “[o]n
 4 information and belief, a review of Defendant's information provided in discovery, including but
 5 not limited to technical specifications and/or source code, will confirm that the facial feature
 6 images are associated with facial feature element codes.” Exh. 3, p. 3, *et seq.* This does not
 7 even mention the “composite facial image codes”, but again refers, apparently in error, to the
 8 “facial feature element codes” limitation.

9 Accordingly, RecogniCorp's claim charts regarding this element do not comply with the
 10 Local Patent Rules, which are designed to “provide defendants' with notice of infringement
 11 beyond that which is provided by the mere language of the patents themselves.” *Network*
 12 *Caching Tech., LLC v. Novell, Inc.*, 2003 U.S. Dist. LEXIS 9881, *13 (N.D. Cal. Mar. 21, 2003)
 13 (“*Network Caching II*”).

14 ***The “first screen” limitation.***

15 RecogniCorp's claim charts give no support to this limitation as to the 3DS. Specifically,
 16 RecogniCorp alleges that: “On information and belief, the two portions of the screen operate
 17 utilizing substantial shared electronics, circuitry, processor(s) and/or software.” Exh. 5, p. 2.
 18 This is tantamount to an admission that RecogniCorp did no investigation whatsoever of the 3DS
 19 as to this element, because the alleged “shared electronics” and “circuitry” (if true) would be
 20 readily apparent as soon as the 3DS is taken apart. Shared electronics and circuitry are physical
 21 things, and if RecogniCorp had performed “reverse engineering or its equivalent,” it could have
 22 included photographs of the product with the alleged shared electronics and circuitry highlighted
 23 and made its allegation *not* “on information and belief” but on facts discovered after due
 24 diligence.

1 ***The “code factor” limitation.***

2 As with both the "facial feature element code" and "composite facial image code"
3 limitations, RecogniCorp's claim charts also fail to support the "code factor" limitation, but again
4 simply parrot the claim language and reiterate that "on information and belief," discovery will
5 allow RecogniCorp to "confirm" the presence of composite facial image codes.³ Exh. 3, p. 10 *et*
6 *seq.* Again, this statement does not provide Nintendo or the Court any more information than the
7 claim language itself.

8 **III. ARGUMENT**

9 **A. Portions Of RecogniCorp's Contentions Should Be Stricken For**
10 **Failure to Show Where Each Limitation Of Each Asserted Claim Is**
11 **Found In The Accused Products.**

12 This district's Local Patent Rules require RecogniCorp to “identify[] specifically where
13 each element of each Asserted Claim is found within each Accused Device.” L.P.R. 120(c). The
14 rules were “designed to require parties to crystallize their theories of the case early in the
15 litigation and to adhere to those theories once they have been disclosed.” *REC Software USA*,
16 2012 U.S. Dist. LEXIS at *8 (*quoting Nova Measuring Instruments Ltd. v. Nanometrics, Inc.*,
17 417 F. Supp. 2d 1121, 1123 (N.D. Cal. 2006)). The specificity required is such that the patent
18 holder must go beyond simply parroting the claim language in its charts. *Network Caching I*,
19 2002 U.S. Dist. LEXIS 26098, *18. In *Network Caching I*, Judge Walker held that the minimum
20 level of prefiling investigation required by Rule 11 (which also sets the standard for the level of
21 detail required by the L.P.R.s) is “reverse engineering or its equivalent.” *Id.* at *5.

22 RecogniCorp has failed to meet these requirements because its ICs fail to identify
23 specifically where each claim limitation is found in each accused product. The contentions have
24 far less detail than would be provided by “reverse engineering or its equivalent,” but instead ask
25 the Court and Nintendo to assume that key claim limitations are present. In the limitations

26 ³ Beyond this, RecogniCorp’s chart simply paraphrases the claim language.

specifically identified above, RecogniCorp's ICs fail to even discuss where or how the limitations are met, and instead merely parrot the claim language.

Here, RecogniCorp's ICs speculate that "on information and belief" the "code" elements must be in Nintendo's devices, and that further discovery will "confirm" the contentions. The phrase "[o]n information and belief, a review of Defendant's information provided in discovery, including but not limited to technical specifications and/or source code, will confirm that . . ." appears in Plaintiff's contentions a total of *93 times*. Such a wholesale copying and pasting of contentions indicates that RecogniCorp did not perform a serious investigation into Nintendo's alleged infringement. *Theranos, Inc. v. Fuisz Pharma LLC*, 2012 U.S. Dist. LEXIS 172160, *17 (N.D. Cal. Nov. 30, 2012) ("Fuisz copies and pastes these [on information and belief] responses throughout its Contentions, further evidencing the presumptive nature of their claims.").

RecogniCorp's ICs suggest that discovery must be conducted before it can state whether any of the "code" limitations can actually be found in any Nintendo products. Apparently, RecogniCorp intends to reserve for itself the opportunity to amend its contentions without regard to whether the Local Patent Rules or the Court will allow such amendment.

Remarkably, RecogniCorp has not served Nintendo with *any* discovery requests even though this case was originally filed (in Oregon) on December 20, 2011, transferred to this Court on October 23, 2012, and the Rule 26(f) conference occurred on January 4, 2013. It is simply improper for RecogniCorp to shift the burden to Nintendo by claiming it needs discovery before it can formulate proper ICs. *Theranos*, 2012 U.S. Dist. LEXIS at *20 ("By arguing that Theranos' information is not publicly available and by offering to amend the Contentions only after discovery has occurred, Fuisz is attempting to ignore their obligations and shift the burden to Theranos. Such tactic is improper." (*citing Bender v. Maxim Integrated Prods. Inc.*, 2010 U.S. Dist. LEXIS 89957, *8 (N.D. Cal. July 29, 2010)).

Further, RecogniCorp is incorrect in implying that it cannot determine whether the "code" limitations are present in Nintendo's products without discovery. In its ICs RecogniCorp

1 asserts claims 11, 20, 26, 33, and 40 against all the accused products. These claims all require
 2 (sometimes using slight language variations) "transmitting the composite image code." Exh. 3, p.
 3 10 *et seq.* The "source code" or other discovery RecogniCorp claims it needs to determine the
 4 presence of, for example, the composite image codes, is in fact *not* needed: if the composite
 5 image code is transmitted as RecogniCorp alleges, that transmission could certainly be detected
 6 with modern equipment, much like a radio receiver can tune in to a radio broadcast.

7 The '303 patent specifies that the "transmission medium 800 between site A 802 and site
 8 B 804 may be a telephone line with a set of modems, an Ethernet connection, the Internet or any
 9 other communication medium suitable for the transfer of data." Exh. 1, Col. 11 ll. 61-65.
 10 RecogniCorp has been free to investigate such data transmission since at least December 2011,
 11 but for some reason has apparently been unwilling to do so. It cannot now shift the burden of
 12 that investigation onto Nintendo without even providing a reason why it believes the code
 13 limitations to be present in Nintendo's products. *CSR Technology Inc. v. Freescale*
 14 *Semiconductor*, 2013 U.S. Dist. LEXIS 17502, *14 (N.D. Cal. Feb. 8, 2013)("In addition, that
 15 the processor runs on software is not responsive to Defendant's argument that the ICs fail to
 16 provide any reason why Plaintiff believes the Accused Products perform the claimed method.").

17 RecogniCorp must do more than simply allege, as it has, that the Accused Devices
 18 contain a processor and also allege that therefore source code will be needed before it can serve
 19 Nintendo with adequate contentions. It must also provide a *reason* why it believes Nintendo
 20 uses "facial feature element codes," "composite facial image codes," and "code factors" as
 21 alleged.

22 **B. The Court Should Relieve Nintendo Of Its Discovery Obligations**
 23 **Under The Local Patent Rules.**

24 This Court has inherent power to relieve Nintendo of its discovery obligations under the
 25 Local Patent Rules until RecogniCorp complies with L.P.R. 120. Other courts in the Ninth
 26 Circuit have exercised that power in similar situations. *See, e.g., Bender v. Maxim Integrated*

1 *Prods.*, 2010 U.S. Dist. LEXIS 32115, *7 (N.D. Cal. Mar. 22, 2010) (noting that “[u]ntil plaintiff
 2 meets the burden of providing infringement contentions compliant with P.L.R. 3-1, the Court
 3 will not order defendant to proceed with discovery”); *Network Caching I.*, 2002 U.S. Dist.
 4 LEXIS 26098 at *18 (ordering all discovery stayed until the patentee “serves its revised
 5 preliminary contentions.”); *Shared Memory Graphics LLC v. Apple, Inc.*, 2010 U.S. Dist. LEXIS
 6 138868, *16 (staying discovery until after patent owner complies with P.L.R. 3-1); *Intertrust*
 7 *Technologies Corp.*, 2003 U.S. Dist. LEXIS 22736, *11 (same).

8 Unless and until RecogniCorp serves ICs that comply with the Local Patent Rules (if it is
 9 allowed to), Nintendo should not be required to produce its invalidity contentions or confidential
 10 technical documents that it would normally be required to produce under L.P.R. 121 and 122,
 11 and in response to any discovery requests. Requiring Nintendo to make its contentions and
 12 disclose its confidential documents before RecogniCorp meets its obligations under the rules
 13 would prejudice Nintendo and also defeat the purpose of the rules in requiring RecogniCorp to
 14 commit to its theories of infringement.

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1 **IV. CONCLUSION**

2 RecogniCorp failed to comply with L.P.R. 120 for the reasons stated above. Accordingly,
3 Nintendo respectfully requests that the Court Grant Nintendo's Motion to Strike RecogniCorp's
4 Infringement Contentions, and to relieve Nintendo of discovery obligations pending service of
5 compliant infringement contentions.

6 Dated this 21st day of March, 2013

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of March, 2013, I electronically filed and served the NINTENDO'S MOTION TO STRIKE INFRINGEMENT CONTENTIONS AND TO RELIEVE NINTENDO OF DISCOVERY OBLIGATIONS; MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF with the Clerk of the Court and opposing counsel using the CM/ECF system.

Executed at Seattle, Washington, this 21st day of March, 2013.

/s/ James L. Phillips

James L. Phillips